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Alexander Morozov

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HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

TALBOT, BRIAN K

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

08/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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1. The amendment filed 6/4/09 has been considered and entered. Claims 26 and 27 have been added. Claims 24 and 25 have been canceled. Claims 1-23 and 26-27 remain in the application.

2. This application contains claims 13-23 are drawn to an invention nonelected with traverse in the reply filed on 4/10/08. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. In light of the amendment filed 6/4/09, the objection to the specification concerning the Abstract has been withdrawn with the submission of the new Abstract filed 6/2/09.

4. In light of the amendment filed 6/4/09, the 35 USC 112 and 102 rejections have been withdrawn. However, the following rejections have been necessitated by the amendment.

Claim Rejections - 35 USC § 112

5. Regarding claim 3, the term “said stannic hydroxychloride” lacks antecedent basis. Furthermore, the formula in claim 3 appears to contradict that of claim 1 from which it depends. Clarification is requested.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 03-39497 in combination with Giersberg et al. (5,314,534).

JP 03-39497 teaches a tin and iridium oxide or platinum plating on an anode. The anode is a valve metal and the tin/iridium or palladium coating includes a stannous chloride followed by heating at 400-600°C. The valve metal is titanium (abstract).

JP 03-39497 fails to teach the claimed compound formula.

Giersberg et al. (5,314,534) teaches a stoichiometric stannous hydroxychloride and a non-stoichiometric stannous hydroxyoxalate having a formula similar to that of claims (abstract and claims 1-3)

Therefore it would have been obvious at the time the invention was made to have modified JP 03-39497 to have utilized the compound formula of Giersberg et al. (5,314,534) with the expectation of achieving similar success. Furthermore, it is the Examiner's position that one skilled in the art at the time the invention was made would have had a reasonable expectation of achieving similar success regardless of the particular formula recited. As support

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for this position, JP 03-39497 teaches stannous chloride with a different compound formula with success.

With respect to the Cl/Sn ratio being non-stoichiometric, it is the Examiner's position that the stoichiometry would be a matter of design choice of one skilled in the art with the expectation of similar success. In addition, Giersberg et al. (5,314,534) teaches a Cl/Sn ratio of 1:1 (claim 2).

Regarding claim 11, the claim recites multiple coats. It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 124 USPQ 378 (CCPA 1960).

Response to Amendment

8. Applicant's arguments filed 6/4/09 have been fully considered but they are not persuasive.

Applicant argued that the prior art failed to teach the compound formula now claimed in claim 1.

This has been addressed above in the rejection with the addition of the Giersberg et al. (5,314,534) reference.

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Talbot whose telephone number is (571) 272-1428. The examiner can normally be reached on Monday-Friday 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian K Talbot/
Primary Examiner, Art Unit 1792

BKT